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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,966	12/08/2003	Marco Norma	230253	9044

7590 12/28/2004

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EXAMINER

GILBERT, SAMUEL G

ART UNIT PAPER NUMBER

3736

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,966	Applicant(s) NORMA, MARCO	
	Examiner Samuel G. Gilbert	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Stigar-Brown (6,056,705).

Claim 1 - element -36- is a vibrator means, arm elements -18- and -24- are a clip means. Arm elements -18- and -24- are spring biased. The device is capable of being clipped to the labia and the vibrator would be kept in contact with the clitoris.

Claim 4 - element -36- is a vibrator means, element -34- includes a recess for holding the vibrating means, and recess arm elements -18- and -24- are a clip means. Arm elements -18- and -24- are spring biased. The examiner is taking the recess to be tubular. The device is capable of being clipped to the labia.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Micro-Vibe (page 11, Adam & Eve catalog from 11/29/2001).

The Micro-Vibe includes a set of clips including spring biased arms connected to vibrators. The clips are capable of being used on the labia. The device is capable of

being clipped to the labia and while clipped being positioned such that the vibrator stimulates the clitoris, therefore the structure is a equivalent to the applicant's means language.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Klein(2003/0181784).

Applicant's attention is invited to the embodiment of figures 9-11, elements -41- and -45- are clip arms, element -12- is a vibrator, element -47- is a curved portion, and housing -11- is a holder. A portion of housing -11- towards a base is tubular.

Response to Arguments

The applicant argues the following differences between Stigar-Brown and the claims:

1) Stigar-Brown clamps the clitoris while the claims require clamping the labia. The device of Stigar-Brown can be used to clip the labia on one side of the clitoris and positioned such that the vibrator is in contact with the clitoris, making the device of Stigar-Brown a functional equivalent of the claimed invention. Further, the claims do not recite the amount or portion or position of the clamp on the labia.

2) The applicant argues Stigar-Brown would obstruct vaginal stimulation including penetration. The examiner does not find any limitations in the claims directed to this argument.

3) Another structural difference is the at rest position of the clip induced by spring -32-. The examiner cannot find any limitation in the claims directed to the "at rest position" as argued.

4) The Stigar-Brown patented device cannot be clipped to the labia. The examiner believes that the Stigar-Brown device can be clipped to a portion of the labia on one side of the clitoris, while this is different than the clipping action described by the applicant, the claims set forth by the applicant do not limit how the device is clipped to the labia.

The rejection of Claims 2, 3, 5, and 6 over Stigar-Brown have been withdrawn in view of the applicant's arguments on pages 6 and 7.

5) Klein does not teach a device used on the labia. It is the examiner's position that the clip structure of Klein (the embodiment of figures 9-11) is an equivalent to the clip structure of the applicant in that it is capable of being clipped to the labia and holding the vibrator in position to stimulate the clitoris.

6) The last paragraph on page 8 the applicant argues that the labia should be considered as an element in a claimed combination and because it is non-statutory the combination is statutory and the labia cannot be ignored. The examiner believes that the labia has not been claimed in combination with the applicants claimed structure. If the labia is positively recited as a structural element the combination will be held to be non-statutory. In this manner "printed matter" and the "human body" are treated differently by the office, in that printed matter will not make otherwise statutory matter non-statutory but the human body if claimed in combination with otherwise statutory

subject matter will make that statutory matter non-statutory. As for the claims the structure cited by the examiner are all capable of being used on the labia. The applicant has not limited the structure to contact the labia in any particular way or any particular portion of the labia, claims 1 and 4.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Thursday 6:30-9:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenberg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel G. Gilbert
Primary Examiner
Art Unit 3736

sgg